

REMARKS

Reconsideration of this application is respectfully requested in view of the following remarks.

Claims 10-29 are currently pending in the application and subject to examination.

In the Office Action mailed February 2, 2006, the Examiner rejected claims 10-29 under 35 U.S.C. § 103(a) as being unpatentable over the project Gutenberg "Gutenberg" in view of U.S. Patent No. 5,666,493 to Wojcik ("Wojcik").

Gutenberg is a website which offers free electronic text to be downloaded from an internet site for free. Gutenberg does not provide electronic books for purchase by subscribers. Gutenberg solicits donations, but does not condition any service based on a donation.

In addition, as Gutenberg does not offer books for purchase, Gutenberg does not record an indication of purchases of the electronic books or associate an amount of each purchase with the source for the corresponding electronic book. The Examiner acknowledges this and cites Wojcik as teaching these elements. However, Wojcik does not disclose or suggest associating electronic books with a source of the electronic book, recording an indication of purchases of the electronic books, or associating an amount of each purchase with the source for the corresponding electronic book. Wojcik never discusses an electronic book.

Furthermore, Wojcik does not cure the deficiency in Gutenberg by disclosing or suggesting the element of providing electronic books for purchase by subscribers.

The Applicant submits that neither Gutenberg nor Wojcik disclose or suggest at least the elements of providing electronic books for purchase by subscribers, recording

an indication of purchases of electronic books and associating an amount of each purchase with the source for the corresponding electronic book, as claimed in claim 10, as amended.

Therefore, the Applicant submits that claim 10 is allowable over the cited art, for at least these reasons. Claims 15, 20, and 25 contain limitations similar to those discussed for claim 10. The Applicant submits that claims 15, 20, and 25 are likewise allowable.

Claims 11-14, 16-19, 21-24, and 26-29 depend from allowable claims 10, 15, 20, and 25 and contain further limitations. As claims 10, 15, 20, and 25 are allowable, the Applicant submits that claims 11-14, 16-19, 21-24, and 26-29 are likewise allowable.

With regard to each of the rejections under §103 in the Office Action, it is also respectfully submitted that the Examiner has not yet set forth a *prima facie* case of obviousness. The PTO has the burden under §103 to establish a *prima facie* case of obviousness. In re Fine, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Both the case law of the Federal Circuit and the PTO itself have made clear that where a modification must be made to the prior art to reject or invalidate a claim under §103, there must be a showing of proper motivation to do so. The mere fact that a prior art reference could arguably be modified to meet the claim is insufficient to establish obviousness. The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. Id. In order to establish obviousness, there must be a suggestion or motivation in the reference to do so. See

also In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (prior art could not be turned upside down without motivation to do so); In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994 (Fed. Cir. 1999); In re Lee, 277 F.3d 1338 (Fed. Cir. 2002).

In the Office Action, the Examiner merely states that the present invention is obvious in light of the cited references. See, e.g., Office Action at page 3. This is an insufficient showing of motivation.

The rejection states that it would be obvious to combine the teachings of Wojcik with those of Gutenberg because it would allow the system manager to verify the information recorded for inventory purposes by being able to rapidly give details about stock remaining. This does not make sense, as the Gutenberg project does not involve purchases, inventory, or remaining stock. Instead, Gutenberg maintains a website where free electronic text can be downloaded. There is no motivation to combine the system of Wojcik with Gutenberg.

CONCLUSION

For all of the above reasons, it is respectfully submitted that the claims now pending patentability distinguish the present invention from the cited references. Accordingly, reconsideration and withdrawal of the outstanding rejections and an issuance of a Notice of Allowance are earnestly solicited.

Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is encouraged to telephone the undersigned representative at the number listed below.

In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of time. The fee for this extension may be charged to our Deposit Account No. 01-2300. The Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment associated with this communication to Deposit Account No. 01-2300, with reference to Attorney Docket No. 026880-00034.

Respectfully submitted,

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